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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/524,990	03/14/2000	Rafael Victor Andino	CL/V-30886/A/CGV2116	8536

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EXAMINER	
HECKENBERG JR, DONALD H	
ART UNIT	**PAPER NUMBER**
1722	10

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/524,990	ANDINO ET AL.	
	Examiner	Art Unit	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *the amendment filed on February 13, 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *26-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 March 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Claims 26-35 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method and apparatus, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

tabs -55- (spec. p. 8, ln. 10),

protrusions -57- (spec. p. 8, ln. 26),

tabs -59- (spec. 8, ln. 26),

sprue -134- (spec. p. 22, ln. 21)

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The disclosure is objected to because of the following informalities: The specification contains the symbol --▒--. It is unclear what this symbol is intended to be, and appears to be a typographical error. This symbol occurs at the following locations:

p. 7, ln. 18, before and after the word "base"

p. 7, ln. 23, before and after the word "optical" and the word "lenticular"

p. 7, ln. 27, before and after the word "optical"

p. 7, ln. 28, before and after the word "optical"

p. 10, ln. 4, before the word "meeting" and after the word "surrounding"

p. 12, ln. 2, before the word "curing"

p. 12, ln. 3, before the word "as"

p. 13, ln. 29, before and after the letter "G"

p. 13, ln. 31, before and after the letters "M" and "P"

Appropriate correction is required.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 13-15, 17-18, and 23-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar et al. (US Pat. No. 5,782,460) in view of Portney et al. (US Pat. No. 5,053,171) and Buazza et al. (US Pat. No. 5,989,462).

Kretzschmar teaches an ophthalmic lens mold comprising a first mold half (11) having a front side (13) and a back side,

the front side defining an optical surface, a second mold half (12) having a front side (14) defining an optical surface, wherein alignment of the first mold half and the second mold half form a mold cavity (15) to form an ophthalmic lens (CL) between the opposing surfaces, wherein the first mold half includes a first section (the portion corresponding to the area above 13) that transmits ultraviolet curing light (3) from the back of the mold half to the front of the mold to an area enclosed by an outermost circumference of the ophthalmic lens, and a second section (21) that blocks the UV curing light, the second section disposed as such that it prevents the curing light incident to the back of the mold half from passing to an area that extend radially outward of a boundary of the circumference (col. 11, lns. 7-10).

Kretzschmar fails to teach the first and second sections to be co-molded thermoplastic material including polymethylmethacrylate and butadiene. Kretzschmar also fails to teach the use of collimated light.

Portney teach an apparatus for manufacture of ophthalmic lenses wherein the UV curing light (30) is prevented from reaching areas of the molding surface through the use of a hazy filter (see col. 3, ln. 67 - col. 4, ln. 9). The reference of Buazza teaches that a hazy filter is co-molded from different

thermoplastic materials (col. 73, lns. 16-27). Portney further teach the use of collimated light for the curing of the lens material (col. 3, lns. 41-42).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al. as such to have used a co-molded thermoplastic material for the first and second sections as suggested by Portney because this would be a suitable alternative for preventing the UV curing light from reaching the outer-periphery of the molding material and further would have resulted in the first and second section comprising just simply one piece. It further would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar to have used collimated light because this is a suitable light for the molding of ophthalmic lenses as suggested by Portney.

Regarding the use of the particular thermoplastics polymethylmethacrylate for the first section and polymethylmethacrylate and butadiene for the second section, this would have been obvious to one skilled in the art because these are well-known in the art as suitable thermoplastics that would act as alternatives to the teaching of Buazza of a hazy filter comprising polyethylene and bisphenol (see Buazza, col.

73, lns. 22-27). Note as well, that the selection of known plastics to make a device previously made from plastics prior to the invention, the selection of the plastics being on the basis of suitability for intended use, is obvious. In re Leshin, 277 F.2d 197, 125 USPQ 416 (Cust. & Pat. App. 1960).

8. Claims 5-6, 9-11, 16, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar modified by Portney and Buazza as applied to claims 1-4, 13-15, 17-18, and 23-24 above, and further in view of Doke et al. (US Pat. No. 6,071,111).

Kretzschmar, Portney, and Buazza disclose the apparatus as described above. Kretzschmar, Portney, and Buazza fail to teach the first optical surface to be convex on the first surface (forming the optical surface) with a concave surface on the back side and a uniform thickness between the front side and back side. Kretzschmar, Portney, and Buazza also fail to teach the first mold half and second mold half to include a plurality protrusions extending forward from the front side to bear on the other mold half so that the mold halves form a cavity.

Doke teaches a lens molding apparatus wherein a first mold half (4) comprises a first section with a front convex optical forming surface and a back concave surface with a substantially

uniform thickness therebetween (12), and a second section (10) extending from the front side to the back side. Doke further teach the apparatus to comprise protrusions and an annular collar (18 and 26) on the two mold halves to align the two halves and form the molding cavity (see col. 8, lns. 61-63).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar, Portney, and Buazza as such to have used a first mold half having a convex optical forming surface and a back concave surface with a substantially uniform thickness therebetween because this is a suitable mold construction in forming contact lenses as suggested by Doke. It further would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar, Portney, and Buazza as such to have used protrusions and an annular collar on the mold halves like the ones taught by Doke because this would aid in the alignment of the mold halves in forming the molding cavity.

Regarding the use of a plurality of protrusions, as noted above Doke teaches the use of a protrusion structure. Therefore the use of multiple protrusions would be an obvious modification to one of ordinary skill in the art because this would further aid in the alignment of the mold halves. Normally the

duplication of known parts for multiplied effect is of no patentable significance unless it can be shown that there is a new and unexpected result. See In re Harza, 274 F.2d 669, 124 USPQ 378 (Cust. & Pat. App. 1960); St. Regis Paper Co. v. Bemis Co., Inc., 549 F.2d 833, 193 USPQ 8 (7th Cir. 1977)

9. Claims 7-8, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar modified by Portney, Buazza, and Doke as applied to claims 1-6, 9-11, 13-18, 20-21, and 23-24 above, and further in view of Friske (US Pat. No. 5,254,000).

Kretzschmar, Portney, Buazza, and Doke teach the apparatus as described above. Kretzschmar and Portney, Buazza, and Doke fail to teach the first section of the first mold half to further include at least one tab extending radially outward from the center section to the second section.

Friske teach a lens molding apparatus wherein the first mold half uses tabs (32) extending from the center section for the purpose of securing the mold members together (see col. 3, ln. 62 - col. 4, ln. 2).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar, Portney, Buazza, and Doke as such

to have used tabs extending from the first section into the second section because these tabs would secure the mold members together as suggested by Friske.

10. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar, Portney, Buazza, and Doke as applied to claims 1-4, 13-15, 17-18, and 23-24 above, and further in view of Fogarty (US Pat. No. 5,160,749).

Kretzschmar, Portney, and Buazza, disclose the apparatus as describe above. Kretzschmar, Portney, and Buazza, fail to teach the second mold half to include a back side and a first and second section.

Fogarty teaches a lens mold wherein the first and second mold halves both comprise first and second sides, as well as first and second sections (see fig. 5).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar, Portney, and Buazza as such to have had the first and second mold halves both comprise back sides and first and second sections because this is a suitable design for a lens mold as taught by Fogarty.

11. Applicant's arguments filed February 13, 2002 have been fully considered but they are not persuasive.

The Applicant argues that the hazy filter taught by Portney and Buazza does not block light, and thus is not applicable in a rejection of the Applicant's invention. The Applicant argues that as the filters taught by Portney and Buazza allow for the transmission of some light, they are contrary to the Applicant's invention.

The filters taught by Portney and Buazza do block some of the light. The particular process in which these filters are used in the reference does not use the filter to fully block the light as the Applicant notes. However, the primary reference of Kretzschmar teaches the full blocking of the light in the lens molding process. Therefore, this particular difference is dependent on a different operating process. It is well settled that the intended use and process of an apparatus is used is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963). In this case, as the reference of Kretzschmar teaches the process whereby the curing light is completely blocked around

the periphery of the mold, the use of the co-molded filter to perform this function of completely blocking the light would be obvious in view of the teaching of Portney that it is know to co-mold filters with light blocking properties. The fact that Portney does show the complete blocking of light does not render the combination unobvious. The test of obviousness is not express suggestion of the claimed invention in any or all references, but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. In re Rosselet, 347 F.2d 847, 146 USPQ 183 (Cust. & Pat. App. 1965). This rejection is based on the combination of teaching of the complete blocking of light by Kretzschmar and the co-molded structure taught by Portney that could be modified to do so.

The Applicant further argues that neither Buazza nor Portney are "co-molded" as required by the claims. The Applicant argues that while Buazza teach "that two incompatible materials are molded together" (response p. 4, ln. 24), that the reference fails to teach the materials to be co-molded.

This argument is not understood, as there is no apparent difference between the material being "co-molded" or "molded together." As noted by the applicant, Buzza does teach that the materials are molded together. As shown above in the rejection,

this teaching, in combination with the references of Kretzschmar and Portney, renders the all of the claim limitations obvious.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached at (703) 308-3829. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Donald Heckenberg
April 22, 2002

JAN H. SILBAUGH
SUPERVISORY PATENT EXAMINER
ART UNIT 1732

05/01/02